

REMARKS

Claims 1-35 are pending in the application. It is gratefully acknowledged that the Examiner has still found allowable subject matter in Claims 24 and 25. The Examiner has rejected the claims as follows: Claims 1, 2, 4, 8-11, 16-19, 26-29, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over 3rd Generation Partnership Project 2, C.S0005-0 Version 1.0 (3GPP2) in view of St.-Pierre (U.S. Patent 5,883,888); Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and further in view of Davis et al. (U.S. 4,612,637); Claims 5, 7, 12, 14, 20, 22, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and further in view of Herring (U.S. 6,011,806); Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and Davis, and further in view of Herring; and, Claims 13, 15, 21, 23, 31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and Herring, and further in view of Davis.

Please amend Claims 1, 9, 17 and 27 as set forth herein. No new matter has been added.

With regard to the rejection of independent Claims 1, 9, 17 and 27 under §103(a), the Examiner asserts that the 3GPP2 in view of St.-Pierre teaches all the elements of these claims. Claims 1, 9, 17 and 27 recite that the sequence number or a message identifier is used to identify two or more channel assignment messages.

The claims of the present application relate to a base station that transmits a supplemental channel assignment message including a sequence number or a message identifier to a mobile station in a forward direction and assigns a supplemental channel based on the transmitted message. The supplemental channel assignment message includes a sequence number or a message identifier in order to identify a plurality of supplemental channel assignment messages. That is, the sequence number or the message identifier of the claims of the present application is used to identify two or more channel assignment messages. In addition, the sequence number or the message identifier indicates the sequence of the plurality of the supplemental channel assignment messages, such as the

first supplemental channel assignment message, the second supplemental channel assignment message, etc.

3GPP2 teaches that when there is traffic to be transmitted from a mobile station to a base station, the mobile station transmits to the base station a request for a supplemental channel assignment and in response to the request, the base station transmits a message assigning a channel to the mobile station.

At this time in the process, the sequence number of 3GPP2 is used by the mobile station in order to identify that it is the channel assignment requested by the mobile station.

St.-Pierre relates to seamless soft handoff in a CDMA cellular communication system. Referring to FIG. 4 of St.-Pierre, a mobile station communicates with a first base station (block 42) and then, if a need is detected to perform a handoff to a second base station (block 44), an MSC instructs the second base station to establish communication with the mobile station (block 48). The mobile station receives duplicate communications in a simultaneous manner through both the first base station and the second base station (block 50). Thereafter, the mobile station receives a frame of the communication transmitted from the first base station as well as a frame of the communication transmitted from the second base station (block 58). Next, the mobile station compares sequence numbers included in the frames with each other (block 60). If the sequence numbers of the frames are identical to each other, the mobile station performs diversity combining of the received duplicate communication (block 68). The reason of comparing the sequence numbers in block 60 is because the frame received from the first base station may not be a duplicate with the frame received from the second base station and the duplicated frames may not be simultaneously received. In other words, the sequence number of the St.-Pierre is used to determine whether the received frames are a duplicate of each other.

Thus, a sequence number or a message identifier of the present invention is different from the sequence number of 3GPP2 and St.-Pierre in the use thereof.

Based on at least the foregoing, withdrawal of the rejection of Claims 1, 9, 17 and 27 under §103(a) is respectfully requested.

Further, even if that which is disclosed by St.-Pierre was analogous to the recitations of the claims of the present application, which it is not, the references cannot be combined since there is nothing in 3GPP2 to suggest adding sequence numbers to the channel assignment messages as proffered by the Examiner. 3GPP2 does not disclose a sequence number used to identify two or more channel assignment messages, and therefore the Examiner is using the present application as motivation (i.e. hindsight) for the combination, and is improper.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.01.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). M.P.E.P. 2143.01. Applicants may argue that the Examiner's conclusion of obviousness is based on improper hindsight reasoning. Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure... *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). M.P.E.P. 2145.

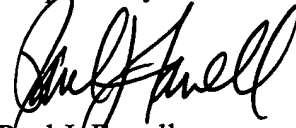
Since the conclusion of obviousness and the reason for combining could be gleaned only from Applicant's disclosure, the rejection is improper.

Based on at least the foregoing, withdrawal of the rejection of Claims 1- 23 and 26-35 is respectfully requested.

Independent Claims 1, 9, 17 and 27 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-8, 10-16, 18-26 and 28-35, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-8, 10-16, 18-26 and 28-35 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-35, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



Paul J. Farrell
Reg. No. 33,494
Attorney for Applicant

DILWORTH & BARRESE
333 Earle Ovington Blvd.
Uniondale, New York 11553
Tel: (516) 228-8484
Fax: (516) 228-8516

PJF/MJM/dr